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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,885	04/24/2006	Mitsuo Kimura	JFE-06-1071	6151

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IP GROUP OF DLA PIPER US LLP
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EXAMINER

FOGARTY, CAITLIN ANNE

ART UNIT	PAPER NUMBER
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4116

MAIL DATE	DELIVERY MODE
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11/15/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/576,885	Applicant(s) KIMURA ET AL.	
	Examiner Caitlin Fogarty	Art Unit 4116	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-48 is/are pending in the application.
- 4a) Of the above claim(s) 37-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-36 and 48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/24/2006, 1/3/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Application

1. Claims 25 – 36 and 48 are pending and presented for the examination. Claims 37 – 47 have been withdrawn from consideration.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

3. The two information disclosure statements (IDSs) were submitted on April 24, 2006 and January 3, 2007, respectively. These submissions are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner. Please refer to applicant's copy of form PTO-1449 submitted herewith.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. The term "about" in claims 25 – 32 and 34 - 36 is a relative term which renders the claim indefinite. The term "about" is not defined by the claim, the specification does

not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 25 – 29, 32 – 36, and 48 are rejected under 35 U.S.C. 102(b) as being anticipated by Kushida et al. (US 6,379,821 B2).

In regards to claims 25 – 29, 32 – 33, and 48, the abstract, col. 3 lines 3 – 11 and Table 5 examples a-c, e, and j-l of Kushida et al. disclose species of a highly corrosion resistant high strength stainless steel pipe for linepipe. It is inherent that the pipes must be welded to create a welded structure in order to create linepipe. Examples a-c, e, and j-l in Table 5 are species with compositions that fall within the claimed genus compositional ranges of claims 25 – 29. A generic claim cannot be allowed to an applicant if the prior art discloses a species falling within the claimed genus. The species in that case will anticipate the genus. In re Slayter, 276 F.2d 408, 411, 125 USPQ 345, 347 (CCPA 1960); In re Gosteli, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989). See MPEP 2131.02. Regarding claim 25, the formulae (1), (2), and (3) would be satisfied by the species taught in Kushida et al. because they fall within they genus compositional ranges of claim 25 required to satisfy the formulae.

Regarding claims 34 – 36, the abstract, col. 3 line 3 to col. 4 line 17, and Table 6 examples 1 – 2, 5, and 10 – 12 of Kushida et al. disclose species with compositions within the ranges of claim 1 that have microstructure within the ranges of claims 34 – 36. Kushida et al. does not disclose that the stainless steel compositions contain any residual austenite phase, however claims 34 – 36 recite that the residual austenite phase is 40% or less or 30% or less by volume so Kushida et al. anticipates this by having 0% residual austenite phase.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 30 – 31 and 34 – 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kushida et al. (US 6,379,821 B2).

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In regards to claim 30 – 31, the abstract, col. 3 line 3 – col. 4 line 17 of Kushida et al. teach a highly corrosion resistant high strength stainless steel pipe with a clearly overlapping composition as shown in the table below.

Element	Claim 30 (mass %)	Kushida et al. (mass %)
C	0.001 – 0.015	≤ 0.05
Si	0.01 – 0.5	0.01 – 1
Mn	0.1 – 1.8	0.05 – 2
P	≤ 0.03	≤ 0.025
S	≤ 0.005	≤ 0.01
Cr	15 – 18	9 – 20
Ni	0.5 – 5.5	0 – 9
Mo	0.5 – 3.5	0 – 5
V	0.02 – 0.2	0 – 0.5
N	0.001 – 0.015	≤ 0.02
O	≤ 0.006	≤ 0.01
Fe + impurities	Balance	Balance
Cu	≤ 3.5	0 – 5

Claim 31 is identical to claim 30 with the exception that the content of Cu is about 0.5 to about 1.14% by mass which also overlaps with the composition of the stainless steel pipe disclosed by Kushida et al. Since the claimed compositional ranges in claims 30 and 31 overlap with the ranges disclosed by Kushida et al., a prima facie case of obviousness exists. See MPEP 2144.05.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

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obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 25 – 36 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 12 of copending Application No. 10/568,154. Although the conflicting claims are not identical, they are not patentably distinct from each other because the composition of the high strength stainless steel pipe recited in Application No. 10/568,154 overlaps in scope

with the composition of the stainless steel pipe recited in claims 25 – 36 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

13. No claim is allowed. All pending claims are rejected.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Caitlin Fogarty whose telephone number is 571-270-3589. The examiner can normally be reached on Monday - Friday 8:00 AM - 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vickie Kim can be reached on (571) 272-0579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CF

/Vickie Kim/

Supervisory Patent Examiner, Art Unit 4116